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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,843	12/27/2000	Taira Hanaoka	14196	6311
23389 7590 03/04/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/748,843

Applicant(s)

HANAOKA ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the paper(s) filed 2/18/2009

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 lines 8-9 state that the memory stores said image and a bookmark icon, indicating that these are two different items, yet the claim continues on line 16 by stating that the stored image *is* the bookmark icon. The claim scope is unclear. The examiner is treating claim 1 as if there is only one item claimed - the stored image being the same as the "bookmark icon".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al (418) (US6546418) in view of Dougherty et al (US6587859) and Turlington (Sams Teach Yourself Netscape Communicator™ 4.5 in 24 Hours).**

6. Regarding claims 1, 3, 6, Schena et al (418) teaches methods and apparatus for scanning printed codes (such as barcode images) which are processed by an extraction element which decodes an associated URL that is used to retrieve advertising information over a network and display it to the user on the apparatus [abstract, 6:19-21]. Schena et al does not teach displaying the scanned image on the apparatus. Schena et al *does* however teach that the user device scans the codes for immediate or delayed processing or for reference and that *the links may be collected, sorted and prioritized locally by the user's device* [10:7-12, 43-47]. Schena et al teaches that the device generates and stores a code file in memory representing a collection of codes scanned and that for example, a user may scan several codes in a magazine or at a store, save them and then later process them [7:61 to 8:5, 12:56-61, 17:40-42]. It would have been obvious to one of ordinary skill at the time of the invention to have stored the history of scanned links as recallable bookmarks so that a user could recall the collection of collected, sorted and locally stored links for future reference, in a manner as is well known with bookmarking websites. This would enable the user to manage and selectively recall previously-stored codes. Dougherty et al also teaches scanning physically printed code in a publication whereby scanning the code with an optical scanner directs the user to a website for more information [abstract, fig 10, 4:54-67, 5:1-6]. Dougherty et al teaches that the scannable codes may have machine readable content (an embedded URL link) *as well as* human-readable image content (as a graphical icon) that indicates the content and/or destination format in the form of a "multicon linkmark" [Note the baseball of Dougherty et al's fig 10 indicates to the user

that by machine-scanning the code of fig 10, the system will automatically link the user to sports-related website content – col 11 lines 19-31 of Dougherty et al]. It would have been obvious to one of ordinary skill at the time of the invention to have included such human-readable image content (as icons) within the machine-scannable code (embedded URLs) of Schena et al (418) so that the suggested collection of bookmarked links are more user-friendly and users can determine what content is available at the destination. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the actual scanned image on the display as a visual thumbnail (i.e. as a bookmark icon) so that Schena et al's suggested collection of collected, sorted and locally stored links can be visually associated with their source printed page and can be selected/launched in order to visit and/or re-visit web content associated with that scanned image of the printed page portion. This would guide the user in identifying what each bookmark stands for, in a similar manner as Dougherty et al's desire to visually indicate to the user what the bookmark represents and enables the user to visually distinguish one bookmark from another while displayed on the screen. One of ordinary skill would recognize the need to keep the plurality of bookmarks distinguishable from one another and by providing a visually identifiable thumbnail image of the scanned source (such as Dougherty's icon-based multicon linkmark) would provide a predictable way to offer that ability to visually distinguish between saved bookmarks. Regarding the previously added feature described on page 16:11-14 of the instant specification that when a stored bookmark icon is selected, the list of bookmarks is displayed - this is a standard feature with devices that offer

bookmarking capabilities. As an example, version 4.5 of the Netscape Communicator browser includes not only the feature to create and recall bookmarks, but includes a bookmark icon that when selected, displays the list of bookmarked resources for the user to browse and select - see Turlington page 57:

The Bookmarks menu lists all your bookmarks. Macintosh users can open the Bookmarks menu from the Menu bar—click the green Bookmarks icon to the right of the Go menu

Schena et al provides many features within the device including using a user interface to select various modes of operation – scan and process, scan and hold, scan and display [9:56-59, 14:7-14]. Given that it would have been obvious to one of ordinary skill at the time of the invention to have provided accessible bookmarked codes as previously argued (and agreed upon by the Board), it also would have been obvious to one of ordinary skill at the time of the invention to have provided a means in the user interface to display the available bookmarks in a manner as taught by Turlington, i.e. via a selectable bookmark icon. Regarding applicant's added claim language directed to a single, handheld device, Schena et al teaches that the receiver may be provided in various forms, including a cell phone, remote control, a personal digital assistant (i.e. a PDA), a pager etc., (each of these are taken by the examiner to be portable, handheld devices) [4:1-8], that the scanner may be a "handheld device" such as a cell phone, remote control, PDA, palmtop, pager, etc., (each of these are taken by the examiner to be portable, handheld devices) and that the scanner and receiver may be integrated into a single device [6:2-3, FIG 3]. This is taken to be a teaching for a single, integrated, handheld device.

7. Regarding claims 4, 5, 7, Schena et al (418) teaches the use of a network url to display advertising on a web page [9:1-5]. The printed publication that includes the coding is taken to provide an article. The displayed content may be video [2:30-56].

8. Regarding claims 8-11, 13, 14, Schena et al (418) teaches that displayed ads are tracked for billing purposes. It would have been obvious to one of ordinary skill at the time of the invention to have provided an accounting server with charge table (database) to keep track of the billing. Schena et al (418) teaches that the billing may be based on the advertising selected and the number of impressions (access number). Official Notice is taken that it is well known to charge for advertising based on other functions such as time of day, the referring article content and the type of ad. It would have been obvious to one of ordinary skill at the time of the invention to have based advertising billing on any of these methods in order to charge the advertiser for the provided ads. Further, Schena et al (418) teaches sharing revenue/fees among all involved parties including bandwidth carrier (ISP provider), advertiser, content provider, etc. It would have been obvious to one of ordinary skill at the time of the invention to have charged the publisher for any portion of any required ISP connection charges so as to reduce/eliminate ISP connections charged for the user – a practice which is well known.

9. Regarding claim 12, Schena et al (418) teaches that the advertising/content displayed may be tailored to the user according to the user's location [7:15-20].

Response to Argument

Regarding applicant's argument against the teachings to provide the scanned image as a bookmark, the examiner has stated above that:

It would have been obvious to one of ordinary skill at the time of the invention to have included such human-readable image content (as icons) within the machine-scannable code (embedded URLs) of Schena et al (418) so that the suggested collection of bookmarked links are more user-friendly and users can determine what content is available at the destination. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the actual scanned image on the display as a visual thumbnail (i.e. as a bookmark icon) so that Schena et al's suggested collection of collected, sorted and locally stored links can be visually associated with their source printed page and can be selected/launched in order to visit and/or re-visit web content associated with that scanned image of the printed page portion. This would guide the user in identifying what each bookmark stands for, in a similar manner as Dougherty et al's desire to visually indicate to the user what the bookmark represents and enables the user to visually distinguish one bookmark from another while displayed on the screen. One of ordinary skill would recognize the need to keep the plurality of bookmarks distinguishable from one another and by providing a visually identifiable thumbnail image of the scanned source (such as Dougherty's icon-based multicon linkmark) would provide a predictable way to offer that ability to visually distinguish between saved bookmarks.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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Primary Examiner
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jdc